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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,752	03/05/2002	Albert D. Johns	02734-0504	7423

7590 12/09/2004

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/087,752

Applicant(s)

JOHNS ET AL.

Examiner

Thu Khanh T. Nguyen

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-3 and 42-49.

Claim(s) objected to: _____.

Claim(s) rejected: 34-40.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 24 February 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Drawings

1. The drawings were received on February 24, 2004. These drawings are accepted.

Response to Arguments

2. Applicant's arguments filed August 17, 2004 have been fully considered but they are not persuasive.

The applicants have alleged that Han (6,261,082) only disclose a die and not a bushing. However, Han discloses that the member 42 includes two portions: a bushing at the upper portion (68 & 70) and a die at the lower portion (72). In agreement with the applicant that the bushing is a "cylindrical metal lining used to constrain, guide, or reduce friction," Han discloses that the upper portion (68) constrains and guides the motion of the punch assembly (46; col. 3, 37-40). Han further discloses that material is pressed only at the lower portion, or the die portion (72; col.3, 54-57); which is different than the bushing portion (68).

The applicant further argued that Han fails to disclose that the tapered portion of the shaft symmetrically engages a tapered portion of the die assembly (as in claim 1). The argument is not commensurate with the scope of claim 34.

Claim 34 only claims a bushing comprising: a) a lumen and b) a tapered recess. Other limitations in the claims are either preamble or functional limitations. The functional limitations have little or no patentability weight in an apparatus claim. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re *Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

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"[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original) It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re *Schreiber*, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re *Spada*, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re *Best*, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and *Ex Parte Gray*, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

Even if the functional limitations have been considered, Han's apparatus is capable of performing those functions. Because the dimension of the bushing portion (68, 70) is slightly larger than the dimension of the ram, the bushing is capable of slidably supporting the ram and receiving the ram, even at the tapered portion (70). The only reason for the very small gap (0.050 inches) at the tapered portion is because explosive materials are used in Han. With other type of material, the gap is not necessary. This intended use, however, does not effect or change the structure limitations of the apparatus.

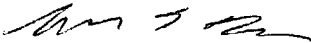
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L. Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN


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SUPERVISORY PATENT EXAMINER
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